

Amendments to the Drawings:

The attached sheet of drawing includes changes to Fig. 6. this sheet, which includes only Fig. 6, replaces the original sheet including only Fig. 6.

Attachment: Replacement Sheet

REMARKS

Drawings

Proposed new drawing Fig. 6 is submitted herewith to show a rinsing device in accordance with claims 34 and 19, and a turbulence-inducing device in accordance with claims 34 and 20. These devices are also mentioned at paragraph [0013] of the application as originally filed. Approval of the proposed drawing amendment is respectfully requested.

Claim Amendments

Independent claim 34 has been amended to include the limitation of claim 17 (now canceled), specifically that the modular treatment station has “a container for receiving liquid used for treatment of said specimens.” The broad limitation in claim 34 regarding “at least one permanently defined function, other than containment of fluid” has been deleted and replaced by a Markush group identifying structure for performing specific functions other than containment of fluid. This amendment is made in view of the suggestion made by the Examiner at the top of page 8 of the Final Office Action (“It is suggested that Applicants claim the appropriate means to perform these other functions”).

Claims 18-21 have been amended to depend from claim 34 instead of claim 17. Claim 22 has been canceled.

Claims 23, 25, 27, 28 have been amended and to adjust dependency and/or more clearly define the claimed subject matter.

Claim Rejections - 35 USC § 102

Claims 2, 4, 6, 11-13, 15-19, and 21-34 are rejected under 35 USC 102(b) as being anticipated by Heid et al. Removal of the rejection is sought based on the following remarks.

The table below is a comparison of claim 34 with the disclosure of Heid et al.

Claim 34	Heid et al.	Limitation present?
a housing	fixed housing part 1b and removable housing part 1a	yes
an array of processing stations within said housing	treatment containers 6a-6j, or a subset thereof	yes

a transport device for delivering the specimens, or object carriers carrying the specimens, into and out of said processing stations	linear guides 8a, 8b; horizontally movable crossbar 9; vertical guide 10; vertically movable slider 11; interface cards 33-36; drives 37-40	yes
a region within said housing proximate to said array of processing stations, said region being reachable by said transport device	A) loading an unloading stations 4 and 5, or B) the region of a treatment container 6a-6j	yes
a modular treatment station received in said region, said modular treatment station being removable from said housing and having a container for receiving liquid used for treatment of said specimens and further having one or more devices chosen from a group consisting of: a heating station for heating liquid in said container, a rinsing device for rinsing specimens, a turbulence-inducing device for inducing turbulence in liquid in said container, and a fan for extracting vapors from said modular treatment station	treatment containers 6a-6j, if read on the claimed "modular treatment station," are merely containers that do not have one or more of the claimed devices	no

The present invention, as defined by claim 34, is not anticipated or suggested by Heid et al. Heid et al. describes removable housing cover portion 1a, removable covers 7 for the containers 6, and presumably removable containers 6. Heid et al. is concerned with preventing dripping contamination of reagents between containers 6 as specimens are transported from one container to another, and thus covers 7 are provided. Heid et al. has nothing to do with a modular treatment station having its own functionality as defined in claim 34.

Regarding claim 12, if the regions of the containers 6a-6j or the regions of loading an unloading stations 4 and 5 are read on the claimed "region for receiving said modular treatment station," then these are not "at least slightly below said array of processing stations" as claimed.

In the Final Office Action, it is noted that the description at column 5, lines 9-12 that air can be evacuated from housing 1(a) has been read on the limitation that the modular treatment station comprises a fan. However, air can be evacuated by lifting cover 1a, or by connecting a vacuum hose or other external suction device to a port provided in the housing. In

any event, even if a fan were used, there is no suggestion that the fan would be provided on a container 6, which is the structure that has been read on the claimed “modular treatment station.”

Regarding claim 23, there is simply no support, if one reads the containers 6 of Heid et al. on the claimed “modular treatment station,” to say that the modular treatment station of Heid et al. includes a container and an extraction chamber adjacent the container, wherein the extraction chamber has a fan.

In view of the foregoing, it is respectfully asked that the anticipation rejection based on Heid et al. be removed.

Claims 2, 4, 6, 11-13, 17, 19, and 21-34 are rejected under 35 USC 102(e) as being anticipated by Thiem et al. ‘225. Removal of the rejection is sought based on the following remarks.

The table below is a comparison of claim 34 with the disclosure of Thiem et al. ‘225.

Claim 34	Thiem et al. ‘225	Limitation present?
a housing	housing shown in Fig. 1	yes
an array of processing stations within said housing	two rows of reagent containers 3, or a subset thereof	yes
a transport device for delivering the specimens, or object carriers carrying the specimens, into and out of said processing stations	transport mechanism including lifting device 7, transport notches 17	yes
a region within said housing proximate to said array of processing stations, said region being reachable by said transport device	A) removal station 8, or B) the region of a reagent container 3	yes

a modular treatment station received in said region, said modular treatment station being removable from said housing and having a container for receiving liquid used for treatment of said specimens and further having one or more devices chosen from a group consisting of: a heating station for heating liquid in said container, a rinsing device for rinsing specimens, a turbulence-inducing device for inducing turbulence in liquid in said container, and a fan for extracting vapors from said modular treatment station	treatment containers 3 or 9, if read on the claimed "modular treatment station," are merely containers that do not have one or more of the claimed devices	no
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The rejection in the Final Office Action based on Thiem et al. '225 reads as follows:

Thiem et al. teach an automated apparatus for the cytological/histological staining of tissue samples comprising a transport basket (4) containing multiple slides (2), reagent containers (3), transport mechanism (6), transporting arms (24), sensors (12) and control/logic circuits (24/25). This has been read on the claimed multiple modular processing stations and transport device to move the sample in and out of the processing stations.

Final Office Action at page 4. It is unclear what structure in Thiem et al. '225 the Patent Office reads on the claimed "modular treatment station" and what structure the Patent Office reads on the other limitations of claim 34 and the limitations of the dependent claims. The comparison table above indicates that Thiem et al. '225 lacks any teaching of a modular treatment station as set forth in claim 34. Therefore, it is asked that the rejection be removed. If the Patent Office does not remove the rejection, then applicants respectfully ask for a more detailed statement of the rejection indicating the structure in the reference that is read on each claim limitation.

Claims 2, 4, 6-13, 15-17, 19 and 21-34 are rejected under 35 USC 102(b) as being anticipated by Thiem et al. '365. Removal of the rejection is sought based on the following remarks.

The table below is a comparison of claim 34 with the disclosure of Thiem et al. '365.

Claim 34	Thiem et al. '365	Limitation present?
a housing	bottom housing part 2 and top housing part 3	yes
an array of processing stations within said housing	circular array of chemical containers 4 and paraffin containers 5, or a subset thereof	yes
a transport device for delivering the specimens, or object carriers carrying the specimens, into and out of said processing stations	turntable 7, rotating device 22	yes
a region within said housing proximate to said array of processing stations, said region being reachable by said transport device	the region of a container 4 or 5	yes
a modular treatment station received in said region, said modular treatment station being removable from said housing and having a container for receiving liquid used for treatment of said specimens and further having one or more devices chosen from a group consisting of: a heating station for heating liquid in said container, a rinsing device for rinsing specimens, a turbulence-inducing device for inducing turbulence in liquid in said container, and a fan for extracting vapors from said modular treatment station	containers 4 or 5, if read on the claimed "modular treatment station," are merely containers that do not have one or more of the claimed devices	no

The rejection in the Final Office Action based on Thiem et al. '365 is similar to that based on Thiem et al. '225 because it is generalized. That being said, the table above is provided to show that claim 34, and the dependent claims, are patentable over this reference. Therefore, removal of the rejection is sought. If the rejection is maintained, then it is requested that the Patent Office specifically identify the structure in the reference that is readable on the "modular treatment station" limitation.

Claim Rejections - 35 USC § 103

Claims 7-10, 14 and 20 are rejected under 35 USC 103(a) as being unpatentable over Heide et al. or Thiem et al. '225. Withdrawal of the rejection is respectfully requested because the references are insufficient as to parent claim 34, and for the following reasons.

Regarding claim 7 and claims 8-10 depending therefrom, it is not understood why it would be desirable to include electrical contacts in a mere container of the prior art (the structure read on the "modular treatment station" of claim 34), because no device is energized. This would only add cost.

Apparently in connection with claim 14, the Final Office Action refers to the covers 7a-7j of Heid et al. for preventing evaporation from the containers and states that "[i]t would have been within the skill of the art to further modify Heid et al. or Thiem et al. (USP 6,635,225) and use covers on the unused positions to gain the above advantages." Heid et al. discloses the covers, so modification of this reference would not be necessary. More importantly, the cover referred to in claim 14 is for closing the access opening in the housing through which modular treatment stations are installed (see access opening 18 and cover 19 in Figs 2 and 3 of the present application). This cover has nothing to do with preventing evaporation from a container as the Patent Office suggests.

Finally, it is noted that while it may be "desirable" to modify Heid et al. or Thiem et al. '225 to provide turbulence, there is no teaching of doing so in a removable module. One skilled in the art at the time the present invention was made, upon reading either or both of these references, would not be steered toward the invention of claim 20.

Claims 14 and 20 are rejected under 35 USC 103(a) as being unpatentable over Thiem et al. '365. Withdrawal of the rejection is respectfully requested for the reasons given above concerning parent claim 34. Also, with respect to claim 20, Thiem et al. 365 contains no teaching that would lead someone skilled in the art at the time the invention was made to provide a turbulence device in a removable module that also includes a container. In other words, modifying Thiem et al. '365 to provide a turbulence-inducing device does not yield the present invention because the turbulence-inducing device would be associated with the overall apparatus, and not part of a removable modular treatment station.

Favorable reconsideration of claims 7-10, 14 and 20 is respectfully requested

Double Patenting

Claims 2, 4, and 6-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- 1) Claims 1-43 of 09/932,900 filed August 20, 2001
- 2) Claims 1-32 of 09/793,199 filed Feb. 26, 2001;
- 3) Claims 1-26 of 10/011,674 filed October 22, 2001; and

4) Claims 1-28 of 09/932,889 filed August 20, 2001.

Applicants addressed double-patenting in detail in the reply dated September 16, 2004 and continue to rely on those arguments. The Final Office Action states at page 8 that "Applicants traverse the Double Patenting rejections arguing the instant application does not teach the specific limitations of the other references." This mischaracterizes applicants' position. Applicants contend that the claimed subject matter of the present application is patentably distinct from the claimed subject matter of the other applications. What the present application "teaches" is irrelevant to double patenting. Removal of the double-patenting rejection is again respectfully sought.

Request for Interview

An Applicant Initiated Interview Request Form is enclosed to request a telephonic interview with the Examiner regarding the issues of 1) the patentability of claim 34 over Heid et al., Thiem et al. '225 and Thiem et al. '365, and 2) the issue of double patenting. The interview is requested inasmuch as the present submission fails to resolve any of these issues.

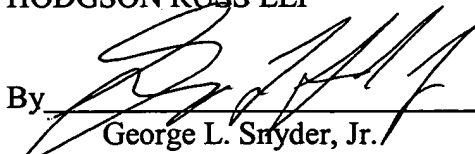
Conclusion

The present application is respectfully considered to be in a condition for allowance, and favorable reconsideration is kindly sought. If the Examiner has any questions, the undersigned attorney may be contacted at the number provided below.

Respectfully submitted,

HODGSON RUSS LLP

By


George L. Snyder, Jr.
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GLS/

Enclosures: Applicant Initiated Interview Request Form
One (1) Replacement Drawing Sheet
Request for Continued Examination
Fee Check for \$790.00
Fee Transmittal

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DATED: March 2, 2005